PATENT
02880/158

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT	:	Pertti TORMALA
SERIAL NO.	:	08/921,533
FILING DATE	:	September 2, 1997
FOR	:	BIOACTIVE AND BIODEGRADABLE COMPOSITES OF POLYMERS AND CERAMICS OR GLASSES AND METHOD TO MANUFACTURE SUCH COMPOSITE
EXAMINER	:	L. Channavajjala
GROUP ART UNIT	:	1615

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

REPLY BRIEF

SIR:

Appellants respectfully submit this Reply Brief in response to the Examiner's Answer of May 21, 2007. Claims 1-6 and 9-22 are pending in the present application, all of which stand finally rejected. Issues in the present appeal are whether claims 1-6 and 9-22 are rendered obvious under the judicially created doctrine of obviousness-type double patenting by claims 1-10 of U.S. Patent No. 6,406,498 to Tormala (the '498 patent) in view of U.S. Patent No. 4,743,257 to Tormala ("the '257 patent") and U.S. Patent No, 4,778,471 to Bajpai ("the '471 patent").

Appellants maintain their original arguments as presented in the Appeal Brief. The following specific points are in response to supplemental arguments provided by the Examiner in the Examiner's Answer.

There is No Motivation to Combine the '471 Patent with the Claims of the '498 Patent

In the Appellant's Appeal Brief, it was argued that a prima facie case of obviousness had not been established since there was no motivation to combine the '471 patent with the claims of the '498 patent. Specifically, Appellants pointed out that the claims of the '498 patent were clearly directed to a surgical composite material that comprises a polymer matrix that has bioactive glass or ceramic dispersed therein. The '471 patent, on the other hand, is directed to a ceramic used as a drug delivery system, cement or grout. The Examiner asserts that the '471 patent teaches the ceramic particles for a bone implant device and cites to col. 4, lines 16-19. However, these lines describe using a "surgical cement or grout composition." The Examiner then points to the preamble of the present claims that recite a composite material for surgical osteosynthesis and asserts that the preamble is generally not given any weight. However, that is not the issue. The issue is whether there is motivation to combine the claims of the '498 patent with the disclosure of the '471 patent. The claims in the '498 patent recite a bioabsorbable surgical composite and the issue is whether disclosure relating to a surgical cement or grout composition would motivate one skilled in the art to modify the claims of the '471 patent, which is directed to a surgical composite. For reasons stated in the Appeal Brief, Appellants submit that it is not.

Further, the Examiner is again dismissive of Appellants' evidence submitted to show that the specific particle sized recited in the claims renders unexpected advantages. The Examiner asserts that "choosing the optimum size of the ceramic particles in the composite material of the '498 [patent], depending [on the] utility of the particles, i.e. to delivery pharmaceuticals, as a cement or group would have been within the scope of a skilled artisan." However, it is not the delivery of pharmaceuticals that makes the particle size of 60 μm and 150 μm critical. Rather, as Appellants have previously explained, this particle size is contrary to the conventional practice of using a smaller particle size and this renders greater biocompatibility and less irritation to tissue compared to particle sizes taught in the art. The Examiner is required to consider this rebuttal evidence (See MPEP 2144.08). For at least these reasons, Appellants again submit that the claims are not rendered obvious by the cited references.

Fee Authorization

Although Appellants believe no fee is associated with this reply brief, the Office is authorized to charge any such fees to Deposit Account No. 11-0600.

Respectfully submitted,

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